



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,297	11/23/1999	SATOSHI KAJITA	01413/FP-469	3644

7590 08/14/2002

WENDEROTH LIND & PONACK LLP
2033 K STREET NW
SUITE 800
WASHINGTON, DC 20006

EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
----------	--------------

2158

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,297

Applicant(s)

KAJITA ET AL.

Examiner

Alina N Boutah

Art Unit

2158

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 2.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

The drawings are objected to because they are not clearly described in the specification, which made them hard to comprehend. A complete revision (description) of figures 3-20, and 27-29 is highly suggested. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2158

Claims 1, 5, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Cree et al (USPN 4,994,985), in further view of Higley (USPN 5,790,793). Regarding claim 1, applicant's prior art teaches a multi-media E-mail system for transmitting/receiving a multi-media E-mail including various types of media information and positioning control information indicating how the media information is each temporally and/or spatially positioned, the multi-media E-mail system comprising: a step of receiving the multi-media E-mail (page 4, lines 3-10; Fig. 26); a step of restoring an incoming mail composed by a sender of the received multi-media E-mail by positioning each of the media information included in the received multi-media E-mail according to the positioning control information included therein (page 4, lines 10-16); a step of storing the media information included in the received multi-media E-mail as received media information (page 7, lines 14-24).

Applicant's admitted prior art fails to teach a step of composing a return mail for the restored incoming mail by utilizing said received media information. Cree et al. teach a step of composing a return mail for the restored incoming mail by utilizing said received media information (Col. 1, Ln. 48-51). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to enable a step of composing a return mail for the restored incoming mail by utilizing said received media information in order to give the user flexibility in managing one's correspondence (Col. 2, Ln. 9-14).

Applicant's admitted prior art and Cree et al. fail to teach a step of transmitting the composed return mail back to said sender in a form of a multi-media E-mail including every media information included in the return mail exclusive of said received media information and the positioning control information indicating how the every media information in the return

Art Unit: 2158

mail is each temporally and/or spatially positioned. Higley teaches a step of transmitting the composed return mail back to said sender in a form of a multi-media E-mail including every media information included in the return mail exclusive of said received media information and the positioning control information indicating how the every media information in the return mail is each temporally and/or spatially positioned (Fig. 6; Col. 5, Ln. 9-12; Col. 7, Ln. 45-52).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to enable a step of transmitting the composed return mail back to said sender in a form of a multi-media E-mail including every media information included in the return mail exclusive of said received media information and the positioning control information indicating how the every media information in the return mail is each temporally and/or spatially positioned so that users can quickly and easily send return multimedia messages in a fast manner (Col. 3, Ln. 2-6; Col. 7, Ln. 21-37).

Regarding claim 5, this is a multimedia e-mail device version of claim 1, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 9, this is a recording medium version of claim 1, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 13, this is a method of supplying a program version of claim 1 wherein all limitations as well as motivations are cited in the same area stated above.

Regarding claim 2, applicant's admitted prior art teaches the multi-media E-mail system according to claim 1, wherein in said step of composing the return mail, said received media information is divided, and the return mail is composed by using divided media information obtained by the division, and in said step of transmitting the return mail, as an alternative to said

Art Unit: 2158

divided media information, division controlling information indicating at where said received media information is divided is transmitted in addition to said multi-media E-mail (Fig. 28).

Regarding claim 6, this is a multimedia e-mail device version of claim 2, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 10, this is a recording medium version of claim 2, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 14, this is a method of supplying a program version of claim 2, wherein all limitations as well as motivations are cited in the same area stated above.

Regarding claim 3, applicant's admitted prior art teaches the multi-media E-mail system according to claim 1, further comprising a step of storing the media information included in the multi-media E-mail to be transmitted as transmitted media information, wherein in said step of restoring the incoming mail, by positioning each media information included in the received multi-media E-mail and said transmitted media information according to the positioning control information included in the multi-media E-mail, the incoming mail is restored (page 4, lines 6-16; page 7, lines 15-23).

Regarding claim 7, this is a multimedia e-mail device version of claim 3, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 11, this is a recording medium version of claim 3, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 15, this is a method of supplying a program version of claim 3, wherein all limitations as well as motivations are cited in the same area stated above.

Art Unit: 2158

Regarding claim 4, applicant's admitted prior art teaches the multi-media E-mail system according to claim 3, wherein in said step of composing the return mail, said received media information is divided, and the return mail is composed by using divided media information obtained by the division, in said step of transmitting the return mail, as an alternative to said divided media information, division controlling information indicating at where said received media information is divided is transmitted in addition to said multi-media E-mail (Fig. 28; page 6, lines 13-15), and in said step of restoring the incoming mail, said transmitted media information is divided according to the division controlling information included in the received multi-media E-mail, and the incoming mail is restored by using the divided media information obtained by the division (page 4, lines 6-16).

Regarding claim 8, this is a multimedia e-mail device version of claim 4, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 12, this is a recording medium version of claim 4, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 16, this is a method of supplying a program version of claim 4, wherein all limitations as well as motivations are cited in the same area stated above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2158

1. USPN 6,327,612 (which claims foreign priority JP 10-010237) issued to Watanabe, teaches a mailing apparatus that appends attachment files for destined TO address but not CC/BCC addresses.

2. USPN 5,995,093 issued to Lambourne et al. teaches a method for configuring a multimedia message for presentation.

3. USPN 5,781,186 issued to Jennings teaches a message creator that specifies inside of a message, how the body components of the message are to be presented to the message recipients.

4. *The Design and Implementation of the MONTAGE Multimedia Mail System*, by W. Keith Edwards, teaches a system for easy composition of messages by typing or importing text, images, and recording sound via a simple sound editor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is (703) 305-5104. The examiner can normally be reached on Monday-Friday (8:30 am- 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9112 for regular communications and (703) 746-9112 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/447,297


Page 8

Art Unit: 2158



ANB

August 9, 2002


DAVID WILEY
PRIMARY EXAMINER